

REMARKS

This paper is presented in response to the Office Action mailed March 10, 2006 (the "Office Action"). Claims 1-29 are now pending in view of the following remarks.

Reconsideration of the application is respectfully requested in view of the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks presented herein, or a lack of remarks, are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and status of the cited references at any appropriate time.

II. Objection to the Abstract

The Examiner has objected to the Abstract of the Disclosure on various grounds. In view of the replacement Abstract of the Disclosure submitted herewith, Applicant submits that the objection has been overcome and should be withdrawn.

III. Information Concerning Drawings

The Examiner indicated has in the Office Action that Applicant's drawings submitted 06 Nov 03 are "acceptable for examination purposes" but "several deficiencies ... are indicated on the PTOL-948 accompanying the instant office action." Notwithstanding the foregoing, it does not appear that any such PTOL-948 was appended to the Office Action. Accordingly, Applicant respectfully requests that the Examiner provide the aforementioned PTOL-948 with the next office action in this case.

IV. Claim Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 2, 21 and 23 under 35 U.S.C. § 112, first paragraph.

With respect to claims 2, 21 and 23, the Examiner has rejected the claims on the grounds that the specification does not enable "graphing byte density over time" because "byte density" is, allegedly, not adequately described in the specification. For at least the reasons set forth below, Applicants respectfully disagree and submit that the rejection should be withdrawn.

Particularly, the description in the specification makes specific reference to the aforementioned terms (see, e.g., paragraphs [0010] and [0026]). Moreover, Figure 2 provides further context for the use of the aforementioned terms. In light of the foregoing, Applicant submits that the meaning of the claim phrases “byte density” and “graphing byte density” would be readily apparent to one of ordinary skill in the art. Accordingly, Applicant submits that examination of the claims using the claim term definitions that the Examiner has created is improper, and the claims must, instead, be examined as written by Applicant.

In connection with the foregoing, Applicants further respectfully submit that the Examiner has failed to establish that the specification would not enable one of skill in the art to practice the claimed invention without undue experimentation.

Specifically, Applicants note at the outset that the Examiner has failed to properly state the test for enablement. Particularly, the test for enablement is not, contrary to the assertion of the Examiner, simply whether the claimed invention was described sufficiently in the specification to enable one skilled in the art to make and use the invention. Rather, it is well established that “The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In Re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).” *MPEP* § 2164.01. *Emphasis added.* In light of the foregoing, Applicants respectfully submit that the enablement test articulated by the Examiner is plainly inconsistent with longstanding U.S. Supreme Court and Federal Circuit precedent.

Applicants note, moreover, that a determination that “undue experimentation” would have been needed to make and use the claimed invention is not easily reached. Particularly, the examination guidelines provide that “there are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any experimentation is ‘undue.’ These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;

- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.”

MPEP § 2164.01(a). Emphasis added. In connection with the foregoing, the examination guidelines further provide that “It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *Id. Emphasis added.*

As to the aforementioned factors, the examination guidelines explain that “The determination that ‘undue experimentation’ would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations.” *Id. Emphasis added.*

As the foregoing makes clear, the Examiner has not only failed to properly state the test for enablement, but the Examiner has likewise failed to address the issue of undue experimentation as such is contemplated by the enablement test. Applicants respectfully submit that the aforementioned deficiencies are fatal to the rejection posed by the Examiner under 35 U.S.C. § 112, first paragraph.

Finally, inasmuch as the Examiner has provided no evidence or analysis whatsoever concerning the purported lack of enablement regarding claims 2, 21 and 23, and has instead simply provided a conclusory statement that the claims fail to comply with the enablement requirement, it appears that the Examiner is relying on personal knowledge as a basis for rejecting claims 2, 21 and 23. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicants hereby respectfully request an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the rejection of claims 2, 21 and 23 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 2, 21 and 23.

For at least the reasons set forth above, Applicants respectfully submit that the rejection of claims 2, 21 and 23 under 35 U.S.C. § 112, first paragraph should be withdrawn.

V. Claim Rejections under 35 U.S.C. § 103(a)

Applicants respectfully note at the outset that in order to establish a prima facie case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 1-6, 9-11, and 13-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,965,574 to Cook et al. (*Cook*) and in view of U.S. Patent No. 6,356,256 to Leftwich (*Leftwich*).

The Examiner has also rejected claims 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over *Cook* and *Leftwich* in view of U.S. Patent No. 6,580,959 to Mazumder (*Mazumder*).

Finally, the Examiner has also rejected claim 12 under 35 U.S.C. 103(a) as being unpatentable over *Cook* and *Leftwich* in view of U.S. Patent No. 6,577,323 to Jamieson (*Jamieson*).

Applicants respectfully disagree and submit that for at least the reasons set forth below, the rejection of claims 1-6, 9-11 and 13-29 should be withdrawn.

a. claims 1-6, 9-11, and 13-29

As to claim 1, the Examiner simply recites the language of claim 1, except for the recitation of claim 1 concerning “storing a histogram,” and then makes the conclusory assertion that “Cook: Figure 3 shows the organization of network traffic. The number of packets, number of bytes, flow start and end time are all present in the network traffic information. Knowing the flow start time and end time gives you the total clock ticks of the capture.” Notwithstanding this assertion, Applicant respectfully notes that the Examiner has completely failed to identify, with any specificity whatsoever, which elements of *Cook* are believed by the Examiner to correspond with the elements and processes recited in claim 1. Moreover, the Examiner has failed to cite any portion of *Cook* in support of the characterization of Figure 3 advanced by the Examiner in the Office Action.

Moreover, Applicant notes that the Examiner appears to be relying on personal knowledge as a basis for rejecting claim 1, and corresponding dependent claims 2-6, 9-11 and 13-18. Particularly, the Examiner has simply stated that “Knowing the flow start time and end time gives you the total clock ticks of the capture” and the Examiner has not identified any references or other materials as being obvious to combine with the purported teachings of *Cook*. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 1-6, 9-11 and 13-18 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 1-6, 9-11 and 13-18.

In connection with the rejection of claim 1, the Examiner has conceded that *Cook* fails to teach the claim 1 limitation "storing a histogram, including the data points, at the user computer" but goes on to assert that "In *Leftwich*: Figure 4 the graph contains tabs for usage statistics and burst management. These would be relating specifically to network traffic." With regard to this assertion, at least, Applicant notes that the Examiner appears to be relying on personal knowledge as a basis for rejecting claim 1 and its corresponding dependent claims 2-6, 9-11 and 13-18. Particularly, the Examiner has simply stated that "the ... tabs ... would be relating specifically to network traffic" but the Examiner has not identified any portion of *Leftwich*, or any other reference, in support of that assertion. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 1-6, 9-11 and 13-18 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 1-6, 9-11 and 13-18.

With regard to claims 9, 13 and 15, it likewise appears that the Examiner is relying as well on personal knowledge as a basis for the rejection of those claims. Particularly, the Examiner has simply stated that:

"The system locates the files when it needs to access them for processing and displaying. Therefore, the system must contain indicators to locate the files it is using." (referring to claim 9);

"The original files were taken from the network monitoring computer and used at the graphical user interface of the user computer to generate the histogram. If the specific files or data is requested that is not at the user computer the network monitoring computer is still fully capable of providing data." (referring to claim 13); and

"If the system can store the data it also will be able to open the stored files. The original files were taken from the network monitoring computer and used at the graphical user interface of the user computer to generate the histogram. If the saved file opens and specific files or data that is requested is not at the user computer the network monitoring computer is still fully capable of providing data" (referring to claim 15).

However, the Examiner has not identified any portion of *Leftwich* or *Cook* in support of those assertions. Nor has the Examiner identified any references or other materials as being obvious to combine with the purported teachings of *Cook* and/or *Leftwich*. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicants hereby respectfully request an Examiner affidavit that: (i) specifically identifies any

and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 9, 13 and 15 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 9, 13 and 15.

As to the motivation for the purportedly obvious combination of *Cook* and *Leftwich*, the Examiner has alleged that it would have been obvious to modify *Cook* with the purported teachings of *Leftwich* in order to “make information easily perceivable by a user.” *Emphasis added*. Applicants note at the outset however that “easily perceivable” is a relative term whose definition is not clear. For example, different users may consider the same method of perceiving information as easy or difficult, depending on considerations such as the knowledge or skill level of the particular user. Moreover, the Examiner has provided no information about a baseline against which the relative ‘ease’ of perceptibility could even be measured. In light of the foregoing, Applicant respectfully submits that the assertion of the Examiner as to the purported obviousness of the allegedly obvious combination is simply speculation.

Moreover, the Examiner has failed, in any event, to establish that the *Cook* apparatus suffers from such shortcomings as could, or would, be remedied by use of the purported disclosure of *Leftwich*. In the absence of any evidence that the *Cook* apparatus is somehow deficient in terms of its ability to make information “perceivable” by a user, Applicants submit that the Examiner has failed to establish the existence of the requisite motivation to make the purportedly obvious combination.

In view of the foregoing, Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness with respect to claim 1, at least because the Examiner has not established the existence of a suggestion or motivation to modify the *Cook* method in the purportedly obvious fashion, and because the Examiner has failed to establish that the references, when combined, teach or suggest all the limitations of claim 1.

Claims 2-6, 9-11 and 13-18 depend from claim 1. By virtue of their dependence from independent claim 1, dependent claims 2-6, 9-11 and 13-18 each require all the limitations of claim 1. As discussed above however, the Examiner has failed to establish that the references, when combined, teach or suggest all the limitations of claim 1, and the Examiner has also failed to establish the existence of a motivation or suggestion to make the purportedly obvious combination. For at least these reasons, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 2-6, 9-11 and 13-18, and the rejection of those claims should accordingly be withdrawn.

Turning now to claims 19 and 23, the Examiner has rejected those claims “using the same rationale as claim 1.” Inasmuch as the rejection of claim 1 is defective for at least the reasons set forth herein in

connection with the discussion of claim 1, Applicant respectfully submits that the rejection of claims 19 and 23 likewise lacks an adequate foundation and should accordingly be withdrawn.

Applicant notes, moreover, that claims 19 and 23 are not the same as each other, or the same as claim 1 and the Examiner has failed to even assert, much less establish, that any of the cited references, alone or in combination, teach or suggest all of the limitations actually recited in claims 19 and 23. As one example, the Examiner has failed to even assert, much less establish, that any of the cited references discloses the claim 19 limitation "... the histogram comprising a first part ... and a second part..."

Claims 20-22 depend from claim 19, and claims 24-29 depend from claim 23. By virtue of their dependence from one of independent claims 19 or 23 however, dependent claims 20-22 and 24-29 each require all the limitations of their respective independent claims, either 19 or 23. As discussed above however, the Examiner has failed to establish that the references, when combined, teach or suggest all the limitations of claims 19 and 23, and the Examiner has also failed to establish the existence of a motivation or suggestion to make the purportedly obvious combination. For at least these reasons, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 20-22 and claims 24-29, and the rejection of those claims should accordingly be withdrawn.

With specific reference to claim 23, the Examiner states that he "takes Official Notice that a top-level folder for organizing data fields into a file structure, along with the naming of the files, folder, etc. that are associated with the file structure, would be obvious to a person of ordinary skill in the art. Many operating systems that have been used and that are used today include this function." In making this statement, it appears that the Examiner is relying on personal knowledge as a basis for rejecting claim 23. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicants hereby respectfully request an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claim 23 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claim 23.

b. claims 7, 8 and 12

As noted above, the Examiner has rejected claims 7, 8 and 12 as being unpatentable over *Cook*, *Leftwich*, and in further view of *Mazumder*. Claims 7, 8 and 12 depend from claim 1. By virtue of their dependence from independent claim 1, dependent claims 7, 8 and 12 each require all the limitations of independent claim 1. As discussed above in connection with claim 1 however, the Examiner has not established that the combination of limitations of claim 1, and therefore claims 7, 8 and 12, is taught or suggested by the purportedly obvious combination of *Cook* and *Leftwich*. Moreover, the Examiner has not established that this defect is remedied by *Mazumder*.

As to the motivation for making the purportedly obvious combinations so as to arrive at the inventions of claims 7 and 8, the Examiner has alleged that it would have been obvious to use a compression algorithm to “enable efficient and fast transmission over a network.” *Emphasis added.* Applicants note at the outset however that “efficient and fast transmission” are relative terms whose definitions are not clear. For example, it is not at all apparent what reference point(s), if any, the Examiner is using as a basis to assert that speed or efficiency would necessarily be achieved as a result of the implementation of the purportedly obvious combination. Moreover, the Examiner has failed, in any event, to establish that the *Cook* apparatus suffers from such shortcomings as could, or would, be remedied by use of the purported disclosure of *Leftwich*. In the absence of any evidence that the purportedly obvious *Cook/Leftwich* combination is somehow deficient in terms of its network transmission speed and/or efficiency, Applicants submit that the Examiner has failed to establish the existence of the requisite motivation to make the purportedly obvious combination.

In view of the foregoing, Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness with respect to claims 7, 8 and 12, at least because the Examiner has failed to establish the existence of a suggestion or motivation to make the purportedly obvious combination, and because the Examiner has failed to establish that the references, when combined, teach or suggest all the limitations of claims 7, 8 and 12.

With specific reference now to the claim 12 rejection, Applicants note that the Examiner appears to be relying on personal knowledge by referencing the rejection to claim 7, which relied on personal knowledge. Particularly, the Examiner has simply states that “An indicator of data location is already part of the data file ...The data plot can then be color coded according to data location.” Notwithstanding these assertions, the Examiner has not identified any portion of *Leftwich*, *Cook* or *Jamieson* in support of those assertions. Nor has the Examiner identified any references or other materials as being obvious to combine with the purported teachings of *Cook* and/or *Leftwich* and/or *Jamieson*. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicants hereby respectfully request an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claim 12 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claim 12.

As to the motivation for making the purportedly obvious combination so as to arrive at the invention of claim 12, the Examiner has alleged that it would have been obvious to color code the captured data in order to “easily provide additional information to the user and to possibly provide navigation to more detailed information.” *Emphasis added.* Applicants note at the outset however that

“easily provide” and “more detailed” are relative terms whose definition is not clear. For example, the Examiner has provided no information about a baseline against which the relative ‘ease’ of the provision of information could even be measured. Similarly, it is not at all apparent what reference point(s), if any, the Examiner is using as a basis to assert that a user could navigate to “more detailed” information. That is, the Examiner has neither defined what constitutes “more detailed” information, nor has the Examiner established that “more detailed” information would necessarily be desirable. In light of the foregoing, Applicant respectfully submits that the assertions of the Examiner as to the purported obviousness of the allegedly obvious combination is simply speculation.

In view of the foregoing discussion, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 12, at least because the Examiner has not established the existence of a suggestion or motivation to make the purportedly obvious combinations. Applicants thus respectfully submit that the rejection of claim 12 should be withdrawn.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-29 in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 10th day of July, 2006.

Respectfully submitted,



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